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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,284	06/12/2000	FRANCOIS SMOLAREK	106498	5209

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EXAMINER
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HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/592,284

Applicant(s)

SMOLAREK, FRANCOIS

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 87,89-98,116,and117 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-11,13-22,24-33,35-44,46-55,57-64,66-76,78-86,99-115,118 and 119 is/are allowed.
- 6) ☒ Claim(s) 129-131 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims pending in the application are 1,3-11,13-22,24-33,35-44,46-55,57-64,66-76,78-87,89-119 and 129-131.

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 August 2005 has been entered.

2. Claims 87, 89-98, 116, and 117 are drawn to a method for manufacturing a stick which is distinct from the other claims, which are drawn to a mold (see previous Office Actions).

In the response of 19 August 2005, Applicant asserts that claim 87 has been amended to include all of the features recited in claims 1, 11, 22, 33, 44, 55, and 75 in Markush format, and thus the method claims should be rejoined with the apparatus claims upon allowance of the apparatus claims.

The inventions of claims 87, 89-98, 116, and 117 and the invention of the originally examined claims are related as process and apparatus for its practice. Rejoinder between these two types of inventions is only appropriate where there is a linking claim in which an recited apparatus includes a means for practicing the process. MPEP § 806.05(e). Claims 87, 89-98,

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116, and 117 do not present such a linking claim, and therefore rejoinder is not appropriate. Moreover, the mold defined within the process recited in claim 87 does not have all the limitations recited in claims 1, 11, 22, 33, 44, 55, and 75 of the instant application. Claim 87 recites the apparatus feature in Markush format. Markush format indicates alternative limitations. MPEP § 2173.05(h). The mold recited in claim 87 need only require one of the features recited in the Markush clause, and thus the mold in claim 87 does not include all of the features recited in any one of claims 1, 11, 22, 33, 44, 55, and 75.

For these reasons, rejoinder of claims 87, 89-98, 116 and 117 is not appropriate. Claims 87, 89-98, 116 and 117 are therefore withdrawn from further consideration as being directed to a non-elected invention.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 129 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

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The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 129 in lines 6 and 7 recites that the recesses formed in the mold comprise "portions that extend on the whole length of the recess adjacent to a periphery of the mold and that are spaced apart." Applicant asserts in the response of 19 August 2005 in discussing claims 129-131, that the prior art reference of Henning does not teach or suggest "notches extend over a whole length of the recess/slit." (response, p. 19, ll. 25 and 26). Claim 129 does not actually use the terminology "notches," however, it is believed apparent from the disclosure of the application that the "notch" referred to by Applicant is the same as the spaced-apart portions of the edges. Therefore, based on Applicant's argument, the language of lines 6 and 7 of claim 129 has been interpreted to require that edge portions both extend the whole length of the recess and are spaced apart about that whole length.

There is no support in the originally filed disclosure for the edge portions being spaced apart over the whole length of the recess. The specification of does not contain any reference

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to edges of the recess not touching over the whole length. While Figure 2 shows the recesses with edges not touching, Figure 2 shows only a single cross section, and thus does not show the recess not touching throughout the whole length. The limitation recited in lines 6 and 7 of claim 129 therefore presents new matter. Note, this issue of lack of support in the originally filed disclosure for the edges not touching over their whole length has been previously been raised in relation to other claims of the application - see in particular the Office Action of 01 December 2003.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 130 and 131 are rejected under 35 U.S.C. 102(b) as being anticipated by Henning (U.S. Pat. No. 3,934,810; previously of record).

Henning discloses a flexible molding device. As shown in Figures 1, 3, 7, and 8, the mold comprises a side wall having an external surface and an internal surface configured to be in

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contact with the product (the internal surface defining a cavity 21 and 81). The side wall includes slits, or "recesses" (27 and 87) facilitating radial deformation of the mold (cl. 1, ll. 59-66). The side wall, however, is deprived of recesses opening out into the internal surface of the mold (see for example, Figs. 3 and 8). The recesses have longitudinal edges having lengths on the external surface (see Figs. 3 and 8). The edges comprise planar portions on the planar external surface that are adjacent to the periphery of the mold, and part of the edges are spaced apart to form channels (33 and 93) which are present prior to any deformation of the mold; that is, when the mold is in an unaltered state. Further, Henning discloses that the depth of the notches may decrease on coming towards a bottom end of the mold (see for example Figs. 2, 4, and 5).

7. Applicant's arguments filed 19 August 2005 with respect to claims 129-131 have been fully considered but they are not persuasive.

With respect to claim 129, Applicant argues that Henning does not teach or suggest that the notches extend over the whole length of the recess/slit. As described above in the rejection under 35 U.S.C. 112, first paragraph, there is no support for this limitation in the originally filed disclosure.



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With respect to claim 130, Applicant asserts that Henning does not disclose non-abutting edge portions which are longitudinal.

The term "longitudinal" is not defined in the specification. The term must therefore be given its broadest reasonable meaning as would be understood by one of ordinary skill in the art. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). In determining the ordinary and customary means that would be attributed to a term by those skilled in the art, dictionary definitions can be used in the process. Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp., 320 F.3d 1339, 1346, 65 USPQ2d 1961, 1965 (Fed. Cir. 2003). Merriam-Webster's Dictionary gives a definition of "longitudinal" as "of or relating to length or the lengthwise direction."

Under this definition, Henning does disclose the recesses to comprise non-abutting edge portions which are "longitudinal" in the form of channels 33. The channels run a partial length of on the side of the mold, and are thus, "longitudinal." Note, it is irrelevant that the non-abutting edges also run in a direction that it is not longitudinal, or do not extend the full longitudinal length of the recess, as claim 130 does not require such configurations.

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With respect to claim 131, Applicant argues that Henning does not disclose non-abutting edge portion of the channel which are "planar."

The entire edge of the recess's of Henning are "planar" as they are formed on the external surface of the mold, and the external surface of the mold is "planar" in that it forms a single two dimensional space. As the entire edge is planar on the surface of the mold, the non-abutting edge portions (channels 33) must be planar as well as they are formed. Henning, therefore, does disclose non-abutting edge portions which are "planar."

8. Claims 1, 3-11, 13-22, 24-33, 35-44, 46-55, 57-64, 66-76, 78-86, 99-115, 118, and 119 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a mold as defined in claims 1, 11, 22, 33, 44, 55, 75, 80, 99, 101, and 115. The closest prior art disclosed by Henning is described in this and the previous Office Actions. Henning fails to teach or suggest the recesses of the mold to comprise edges which are spaced apart over at least part of their length prior to any

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deformation of the mold, with these spaced apart edge portions being spaced from upper and lower ends of the recess. Henning shows the edges to comprise portions at channels 33 and 93 which are spaced apart. These spaced apart edge channels are located, however, at the top and bottom of the recess, not at a location spaced from upper and lower ends of the recess as recited in claims 1, 11, 22, 33, 44, 55, 75, and 99. See also the reasons for indicating allowable subject matter in the previous Office Actions.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

A handwritten signature in dark ink, appearing to read 'Donald Heckenberg', is written over the printed name.

9-14-5

Donald Heckenberg  
Primary Examiner  
A.U. 1722